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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,183	01/13/2000	Daniel R. Tretter	10980251-1	8066

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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,183	Applicant(s) TRETTER ET AL.	
	Examiner Christopher J Brown	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 7/02/2004 have been fully considered but they are not persuasive.

Applicant argues that Choudhury suggests "the decryption key is programmed into the printer. The printer always has the same unique identity." Although Choudhury does state that the printer has a key, Choudhury does not teach that the printer always has the same key or unique identity. Choudhury in fact states that the printer may have secret "keys" (col 4 lines 10-12) meaning that the printer according to the applicant's argument, could have a number of identities. Even if the printer only had one key, as the applicant suggests, the printer would have to establish its initial identity with a server. However, the point is moot because the examiner does not rely on Choudhury to establish the printer identity with the server.

Applicant argues that Pogue is a non-analogous art and that there is no motivation to use said reference. The examiner argues that the system for unlocking doors described in Pogue is only an example of the true system, which is Secure remote access, as the title describes. Pogue teaches that this system may be used in computer system security (Col 2 lines 35-40) which is pertinent to the applicant's document distribution through a computer network. Although Pogue may not specifically state that a remote is a printer or a base is a server, the architecture is analogous to computer system architecture and the

method of establishing identity and security is easily implemented. The examiner once again points to Pouge Col 1 line 43 for motivation, because distributing documents over a network needs a high amount of computer security.

Applicant argues that for Claim 6 the references do not show ordering a document prior to establishing a printer identity. The examiner agrees that Peairs does not specifically teach ordering a document prior to establishing a printer identity. The examiner must fall back on the combination of Choudury and Pouge. It would be inherent in this combination that someone would order a document in Choudury before the challenge response mechanism of Pouge was activated to establish a printer identity. The applicant's argument is not persuasive.

Applicant argues that for Claim 11, the references do not teach the step of using the printer to indicate status of the printing so that the server can charge for copies actually printed. The applicant argues "this step implies that the printer sends back a status acknowledgement to the server". However the examiner must interpret the claims in the broadest possible manner. The applicant's argument does not appear in claim 11. If the applicant wished to amend the claim to include said argument, Claim 11 would be in a better position for allowance, if it was in line with the instant specification and no new matter was added.

2. Rejections for all other claims can be found in the previous office action included below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 9, 10, 12, 13, 18, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury US 5,509,074 in view of Pouge Jr US 5,144,667.

1. As per claim 1, Choudhury discloses a method using a printer to distribute a document stored on a server, the server being connected to a network, (Col 4 lines 18-21). Choudhury discloses using the printer to decrypt the document, (Col 4 lines 25-26). Choudhury discloses using the printer to print the decrypted document, (Col 4 line 26).

Choudhury does not disclose using the printer and at least one key to establish a printer identity with the server.

Pouge Jr. discloses an authentication method that has a server (base) send an encrypted token to a printer (remote unit), (Col 4 line 64). Pouge Jr. discloses that the printer (remote unit) uses a decryption key to decrypt the token, and send the result back to the remote unit (base), (Col 5 lines 24-30). If the token from the printer matches the token at the remote unit, the printer is authenticated, and the identity is established.

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It would be obvious to one of ordinary skill in the art to modify Choudhury's printing system with Pouge Jr's authentication system, because it provides a high level of security, (Pouge Jr. Col 1 line 43).

As per claim 5, Choudhury discloses an embedded processor (special hardware), wherein the processor is used to perform decryption, (Col 2 lines 60-62).

As per claim 9, Choudhury does not disclose authentication.

Pouge Jr. discloses authentication as a security measure. It would be obvious to authenticate the printer before documents were ordered.

As per claim 10, 23 Choudhury discloses using the printer to render (print) the decrypted document, (Col 4 line 26).

As per claims 12, and 18, Choudhury discloses a remote print server with stored documents, (Col 4 lines 18-21). Choudhury discloses sending a network printer (agent) with the means to read a decryption key, (Col 7 lines 45-46). Choudhury discloses means for receiving an encrypted document from the network, (Col 4 lines 25-26). Choudhury discloses using a decryption key to decrypt the document and print it.

Choudhury does not disclose receiving an encrypted token, decrypting it, and sending the decrypted token back to the remote site.

Pouge Jr. discloses an authentication method that has a remote site (base) send an encrypted token to a printer (remote unit), (Col 4 line 64). Pouge Jr. discloses that the printer (remote unit) uses a decryption key to decrypt the token, and send the result back to the remote unit (base), (Col 5 lines 24-30). If the token from the printer matches the token at the remote unit, the printer is authenticated.

It would be obvious to one of ordinary skill in the art to modify Choudhury's printing system with Pouge Jr's authentication system, because it provides a high level of security, (Pouge Jr. Col 1 line 43).

As per claim 13, Choudhury discloses using a client (users computer) to order the document, (Col 7 lines 31-33).

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As per claim 20, Choudhury discloses the printer has a keypad where the document may be obtained using the keypad, (Col 4 lines 26-30). It is well known that printers have displays.

Claims 2, 11, 17, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury US 6,378,070 in view of Pougé Jr. US 5,144,667 and in view of Furman US 5,483,653.

2. As per claim 2, and 22 Choudhury as modified above, discloses sending an encrypted document to a printer. Choudhury does not disclose a message that indicates the number of copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number of copies to be printed, where the printer prints the number of document copies indicated in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify Choudhury's encryption of documents with Furman's printer instructions because it provides the printer with needed instruction.

As per claim 11, 17, and 21, It would be obvious that Choudhury's disclosed printer would contain a status display. Choudhury does not disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify Choudhury's print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Claims 3, 4, 15, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury US 5,509,074 in view of Pougé Jr US 5,144,667 in view of Mandelbaum US 5,552,897.

3. As per claim 3, and 4, Choudhury does not disclose a smart card, or establishing a Printer Identity.

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Pouge Jr. discloses an authentication method that has a server (base) send an encrypted token to a printer (remote unit), (Col 4 line 64). Pouge Jr. discloses that the printer (remote unit) uses a decryption key to decrypt the token, and send the result back to the remote unit (base), (Col 5 lines 24-30). If the token from the printer matches the token at the remote unit, the printer is authenticated, and the identity is established.

It would be obvious to one of ordinary skill in the art to modify Choudhury's printing system with Pouge Jr's authentication system, because it provides a high level of security, (Pouge Jr. Col 1 line 43).

Mandelbaum discloses a smart card reader with a printer (facsimile) where the smart card performs decryption for the printer, (Col 3 lines 35-40, 60-64).

It would be obvious to combine Mandelbaum's smart card with the modified Choudhury because the smart card provides secure encryption keys.

As per claim 15, Choudhury does not disclose a smart card interface.

Mandelbaum discloses a smart card to perform decryption, passing the decrypted document to the printer, (Col 6 lines 26-34).

As per claim 16, Choudhury discloses a processor (special hardware or firmware) in a printer to decrypt a document, (Col 2 lines 60-63). Choudhury discloses that the user provides a key to the printer (agent), (Col 7 lines 45-47). Choudhury does not disclose using a smart card.

Mandelbaum discloses a smart card to pass a key (senders public key) to the printer, as is known in the art, (Col 4 line 53-55).

It would be obvious to combine Mandelbaum's smart card with the modified Choudhury because the smart card provides secure encryption keys.

As per claim 19, Choudhury discloses a network printer with a network interface, and a processor (hardware, firmware), to decrypt a document (Col 1 lines 35-55, Col 2 lines 60-65). Choudhury does not disclose use of smart card.

Mandelbaum discloses a smart card to perform decryption, passing the decrypted document to the printer, (Col 6 lines 26-34).

Claims 6-8, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury US 6,378,070 in view of Pouge Jr. US 5,144,667 and in view of Peairs US 5,717,940.

4. Choudhury as modified above shows the limitations of Claim 1.

As per claim 6, Choudhury does not disclose ordering a document before establishing an identity. Peairs discloses ordering a document without regard for printing. The printer identity is not established, (Col 2 lines 44-60).

As per claim 7, Choudhury does not disclose that the printer is used to order the document. Peairs discloses that the printer may be used to order the document, (Col 3 lines 10-23).

As per claims 8, and 14, Choudhury does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59). It would be obvious for one skilled in the art to modify Choudhury's printing system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

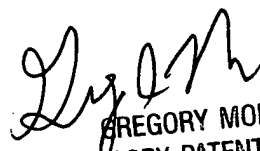
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Brown

12/9/2004



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